

REMARKS

This amendment and related remarks that follow are intended to place the subject application in condition for allowance. Amendments to the specification are presented on page 3. Specifically, in paragraph [0020] the word "in" is added and in paragraph [0068] the word "of" is added, both of which are intended to better disclose the Applicant's invention. No new matter is introduced as a result of these specification amendments. Amendments to the claims are presented starting on page 5. Specifically, claim 1 is amended to disclose the physical structure of the claimed system as required by 35 USC §101, and also to clarify the Applicant's invention. Claim 24 is amended to clarify and better claim the Applicant's invention. Claim 37 is amended to clarify the Applicant's invention. No new matter is introduced as a result of these claim amendments. In view of these amendments and the following reasoning for allowance, the Applicant hereby respectfully requests further examination and reconsideration of the subject application.

1. **Rejection of Claims 1, 2 and 4-23 Under 35 USC §101**

The aforementioned Office Action of August 9, 2005 rejected claims 1, 2 and 4-23 under 35 USC §101 as not explicitly disclosing the embodiment of the claimed system. **Claim 1 is amended herein to disclose the physical structure of the claimed system** as required by 35 USC §101. Specifically, the words "using a computing device for" were added to the end of the preamble.

2. **Rejection of Claims 37-50 Under 35 USC §101**

The aforementioned Office Action of August 9, 2005 rejected claims 37-50 under 35 USC §101 as not being limited to statutory subject matter, and therefore as being non-statutory. In particular, the Office Action suggested that the claimed computer-readable medium is not limited to tangible embodiments since the Applicant's specification discloses said medium as encompassing communications media, which may be intangible matter such as a carrier wave (see specification, page 11, [0035]).

The Applicant respectfully disagrees with the suggestion that claims 37-50 are directed to non-statutory subject matter, and therefore disagrees with the rejection of claims 37-50. In particular, **if claims 37-50 are construed as the Examiner suggests, they would in essence be claiming a modulated signal, such as a carrier wave, that includes the claimed instructions.**

The USPTO recognizes such a claim as patentable subject matter. Evidence of this can be found in the training materials associated with the USPTO's Examination Guidelines for Computer-Related Inventions (available for viewing at the following address: http://www.uspto.gov/web/offices/pac/dapp/mpep_examguide.html.) In an example case entitled "Automated Manufacturing Plant," claim 13 is analyzed and found to be a statutory article of manufacture claim. This claim was directed toward "a **computer data signal embodied in a carrier wave**." Note that this claim analysis is available for viewing at <http://www.uspto.gov/web/offices/pac/dapp/pdf/compenex.pdf>. However, a copy of the analysis of claim 13 from the Guidelines and the results thereof is attached to this response. In particular, on attached page 39, notes 3 and 4 recite the following with respect to carrier waves:

Note 3: "Claimed invention recites specific software embodied on a computer-readable medium, i.e., specific software embodied in a carrier wave." (emphasis added)

Note 4: "Most likely, the "data signal" does not occur as a natural phenomenon. The Examiner bears the burden of establishing that a claimed invention is a natural phenomenon. Therefore, absent object evidence to support the position that the "data signal" is a natural phenomenon, such a position would be untenable." (emphasis added)

Accordingly, given that claims 37-50 are directed toward statutory subject matter, it is respectfully requested that the rejection of these claims be reconsidered.

3. **Rejection of Claims 1, 4-6, 9, 11 and 20 Under 35 USC §103(a)**

The aforementioned Office Action of August 9, 2005 rejected claims 1, 4-6, 9, 11 and 20 under 35 USC §103(a) as being obvious over Lee, Pub. No. US 2002/0087521 A1, in view of Thorner et al., US Patent No. 6,463,443 (hereinafter Thorner). The Applicant respectfully disagrees with this contention of obviousness.

More particularly, **Lee teaches methods for parsing electronic files** to identify words or word sequences which represent candidate personal names. **Lee does not teach methods for automatic electronic database searches or related data retrieval relating to each identified person.**

Thorner teaches database search methods for finding catalogue data associated with persons and/or organizations, e.g., name, postal address, telephone number, fax number, email address and Internet address. However, **Thorner teaches that said database searches and subsequent data retrieval are initiated manually by the user** (not initiated automatically as claimed by the Applicant), **and all search criteria are manually entered by the user in advance of beginning the search** (search criteria are not automatically derived as claimed by the Applicant). This is reinforced throughout Thorner including, for example:

“The desired information and adequate search criteria may be asked for from the terminal.” (refer to Abstract)

“asking for the desired information and adequate search criteria from the terminal means” (refer to column 2, lines 30-32)

“A person A at the computer 1 states that he/she intends to make a database search for a person ... First the catalogue 7 sends a menu regarding what kind of data which is already known ... The person A may fill in the known features directly, for instance, via the keypad of the computer.” (refer to column 4, lines 39-57)

Consequently, the Applicant believes that the Lee-Thorner combination would provide a system wherein particular words are identified in a parsed document (Lee contribution).

The identified words would include links (Lee contribution) for **manually** initiating database searches for information relating to the identified words (Thorner contribution).

In order to deem the Applicant's claims unpatentable under 35 USC §103(a), a prima facie case showing obviousness must be made. To make a prima facie case showing obviousness, *all* of the elements of the recited claims must be considered, especially when they are missing from the prior art. If a claimed element is *not* taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was an error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Based on the arguments presented above, **neither Lee nor Thorner teach the Applicant's claimed system for automatically retrieving, from at least one electronic database, information relating to each identified person resulting from the automatic parsing of an electronic document.** Accordingly, no prima facie case of obviousness has been established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that rejected claims 1, 4-6, 9, 11 and 20 are patentable under 35 USC 103(a) over Lee in view of Thorner. Accordingly, it is respectfully requested that these claims be reconsidered based on the non-obvious claim language as exemplified in claim 1:

“automatically parsing an electronic document, said electronic document including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, to identify data representing any person;
identifying at least one person represented by the identified data;
automatically retrieving information relating to each identified person from at least one electronic database;”

4. **Rejection of Claims 24, 25, 35 and 36 Under 35 USC §103(a)**

The aforementioned Office Action of August 9, 2005 rejected claims 24, 25, 35 and 36 under 35 USC §103(a) as being obvious over Lee in view of Thorner. The Applicant respectfully disagrees with this contention of obviousness.

More particularly, **Lee teaches methods for parsing only electronic files** to identify words or word sequences which represent candidate personal names. **Lee does not teach methods for scanning electronic data being rendered on a computer display device** (as claimed by the Applicant). This is reinforced by the following statement in Lee:

“The electronic file may be for example a text file (such as a .txt file) or an html file. In the later case, and for similarly structured files, the file may be pre-processed to remove mark-up tags.” (refer to page 1, paragraph [0016])

In contrast, the **Applicant claims a system for automatically scanning electronic data being rendered on a computer display device**. In view of the detailed description provided in the Applicant's specification, it should be clear that this is *not* interpreted to mean that a document is first scanned and then rendered on the display device, but rather, that the **Applicant's claimed system is directly scanning the information being rendered on the display device itself** to identify data representing any person. This embodiment is particularly useful when a document's electronic file is not directly available to a computing device for parsing. In paragraph [0068] of the Applicant's specification, the Applicant discloses one method in which information being rendered on a display device may be parsed or scanned to identify information representing at least one person. In particular, said paragraph in said specification states:

“This working example automatically interfaces with display rendering routines of a computer system. The display screen of a computer is rendered in response to instructions, i.e., the display input, such as, for example compiled software code, such as a typical computer program, or, interpreted page descriptions such as HTML or similar script. Consequently, this working example essentially parses all information viewable by the user, as well as hidden text or instructions, such as, for example, hidden text embedded in the HTML code of an

Internet web page, to find persons. Specifically, the working example is capable of scanning the display input looking for known names, email addresses (using the canonical form of XXX@YYY.ZZZ), phone numbers, etc., or any data that may represent a person, as described above.”

The Applicant raised this point regarding scanning data being rendered on a display device in Applicant's previous Office Action response dated July 20, 2005 but it was not addressed by the Examiner.

As discussed in section 3 above, **Thorner** teaches database search methods for finding catalogue data associated with persons and/or organizations, e.g., name, postal address, telephone number, fax number, email address and Internet address. However, **Thorner teaches that said database searches and subsequent data retrieval are initiated manually by the user** (not initiated automatically as claimed by the Applicant), **and all search criteria are manually entered by the user in advance of beginning the search** (search criteria are not automatically derived as claimed by the Applicant). This is reinforced throughout Thorner including, for example, the statements from the Abstract, column 2: lines 30-32, and column 4: lines 39-57, each recited in section 3 above.

Based on these arguments, **neither Lee nor Thorner teach the Applicant's claimed computer-implemented process for automatically scanning electronic data being rendered on a computer display device**. Additionally, **neither Lee nor Thorner teach the Applicant's claimed computer-implemented process for automatically retrieving, from at least one electronic database, information relating to each identified person resulting from the automatic scanning of said electronic data**. Accordingly, no prima facie case of obviousness has been established in accordance with the holding of In Re Fine. This lack of prima facie showing of obviousness means that rejected claims 24, 25, 35 and 36 are patentable under 35 USC 103(a) over Lee in view of Thorner. Accordingly, it is respectfully requested that these claims be reconsidered based on the non-obvious claim language as exemplified in claim 24:

“automatically scanning electronic data being rendered on the computer display device to identify information within the electronic data that represents at least one person;

identifying each person represented by the identified information;
automatically retrieving information relating to each identified person from at least one electronic database;"

5. Rejection of Claim 2 Under 35 USC §103(a)

The aforementioned Office Action of August 9, 2005 rejected dependent claim 2 under 35 USC §103(a) as being obvious over Lee in view of Thorner and further in view of Srinivasan, US Patent No. 6,717,936. The Applicant respectfully disagrees with this contention of obviousness.

More particularly, based on the arguments presented in section 3 above and the Examiner's statements regarding Srinivasan, **neither Lee, Thorner nor Srinivasan teach the Applicant's claimed system for automatically retrieving, from at least one electronic database, information relating to each identified person resulting from the automatic parsing of an electronic document.** Accordingly, no prima facie case of obviousness has been established in accordance with the holding of In Re Fine. This lack of prima facie showing of obviousness means that rejected claim 2 is patentable under 35 USC 103(a) over Lee in view of Thorner and further in view of Srinivasan. Accordingly, it is respectfully requested that this claim be reconsidered based on the non-obvious claim language as exemplified in claim 1 and recited in section 3 above.

6. Rejection of Claims 7 and 8 Under 35 USC §103(a)

The aforementioned Office Action of August 9, 2005 rejected dependent claims 7 and 8 under 35 USC §103(a) as being obvious over Lee in view of Thorner and further in view of Dimitrova, US Patent No. 6,363,380. The Applicant respectfully disagrees with this contention of obviousness.

More particularly, based on the arguments presented in section 3 above and the Examiner's statements regarding Dimitrova, **neither Lee, Thorner nor Dimitrova teach the Applicant's claimed system for automatically retrieving, from at least one electronic database, information relating to each identified person resulting from the**

automatic parsing of an electronic document. Accordingly, no prima facie case of obviousness has been established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that rejected claims 7 and 8 are patentable under 35 USC 103(a) over Lee in view of Thorner and further in view of Dimitrova. Accordingly, it is respectfully requested that these claims be reconsidered based on the non-obvious claim language as exemplified in claim 1 and recited in section 3 above.

7. Rejection of Claims 10 and 12 Under 35 USC §103(a)

The aforementioned Office Action of August 9, 2005 rejected dependent claims 10 and 12 under 35 USC §103(a) as being obvious over Lee in view of Thorner and further in view of Sorensen, US Patent No. 6,628,729. The Applicant respectfully disagrees with this contention of obviousness.

More particularly, based on the arguments presented in section 3 above and the Examiner's statements regarding Sorensen, **neither Lee, Thorner nor Sorensen teach the Applicant's claimed system for automatically retrieving, from at least one electronic database, information relating to each identified person resulting from the automatic parsing of an electronic document.** Accordingly, no prima facie case of obviousness has been established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that rejected claims 10 and 12 are patentable under 35 USC 103(a) over Lee in view of Thorner and further in view of Sorensen. Accordingly, it is respectfully requested that these claims be reconsidered based on the non-obvious claim language as exemplified in claim 1 and recited in section 3 above.

8. Rejection of Claims 13-15 Under 35 USC §103(a)

The aforementioned Office Action of August 9, 2005 rejected dependent claims 13-15 under 35 USC §103(a) as being obvious over Lee in view of Thorner and further in view of Yamakita, US Patent No. 6,272,490. The Applicant respectfully disagrees with this contention of obviousness.

More particularly, based on the arguments presented in section 3 above and the Examiner's statements regarding Yamakita, **neither Lee, Thorner nor Yamakita teach the Applicant's claimed system for automatically retrieving, from at least one electronic database, information relating to each identified person resulting from the automatic parsing of an electronic document.** Accordingly, no prima facie case of obviousness has been established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that rejected claims 13-15 are patentable under 35 USC 103(a) over Lee in view of Thorner and further in view of Yamakita. Accordingly, it is respectfully requested that these claims be reconsidered based on the non-obvious claim language as exemplified in claim 1 and recited in section 3 above.

9. Rejection of Claims 26-30 Under 35 USC §103(a)

The aforementioned Office Action of August 9, 2005 rejected dependent claims 26-30 under 35 USC §103(a) as being obvious over Lee in view of Thorner and further in view of Yamakita, US Patent No. 6,272,490. The Applicant respectfully disagrees with this contention of obviousness.

More particularly, based on the arguments presented in section 4 above and the Examiner's statements regarding Yamakita, **neither Lee, Thorner nor Yamakita teach the Applicant's claimed computer-implemented process for automatically scanning electronic data being rendered on a computer display device.** Additionally, **neither Lee, Thorner nor Yamakita teach the Applicant's claimed computer-implemented process for automatically retrieving, from at least one electronic database, information relating to each identified person resulting from the automatic scanning of said electronic data.** Accordingly, no prima facie case of obviousness has been established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that rejected claims 26-30 are patentable under 35 USC 103(a) over Lee in view of Thorner and further in view of Yamakita. Accordingly, it is respectfully requested that these claims be reconsidered based on the non-obvious claim language as exemplified in claim 24 and recited in section 4 above.

10. Rejection of Claims 37, 38, 40-45 and 50 Under 35 USC §103(a)

The aforementioned Office Action of August 9, 2005 rejected claims 37, 38, 40-45 and 50 under 35 USC §103(a) as being obvious over Lee in view of Thorner and further in view of Yamakita, US Patent No. 6,272,490. The Applicant respectfully disagrees with this contention of obviousness.

More particularly, similar to the discussion in section 4 above, **Lee teaches methods for parsing only electronic files. Lee does not teach methods for parsing or detecting any information in an electronic document rendered on a computer display device** (as claimed by the Applicant). This is reinforced by the Lee statement on page 1, paragraph [0016] recited in section 4 above.

In contrast, the **Applicant claims a computer-readable medium having computer executable instructions for automatically detecting any information in an electronic document rendered on a computer display device.** In view of the detailed description provided in the Applicant's specification, it should be clear that this is *not* interpreted to mean that a document is first scanned and then rendered on the display device, but rather, that the **Applicant's claimed system is directly detecting the information being rendered on the display device itself** to identify any information that represents a person. This embodiment is particularly useful when a document's electronic file is not directly available to a computing device for parsing. In paragraph [0068] of the Applicant's specification, recited in section 4 above, the Applicant discloses one method in which information being rendered on a display device may be parsed or scanned to identify information representing at least one person.

As discussed in section 3 above, Thorner teaches database search methods for finding catalogue data associated with persons and/or organizations. However, **Thorner teaches that said database searches and subsequent data retrieval are initiated manually by the user** (not initiated automatically as claimed by the Applicant), **and all search criteria are manually entered by the user in advance of beginning the search** (search criteria are not automatically derived as claimed by the Applicant). This is

reinforced throughout Thorner including, for example, the statements from the Abstract, column 2: lines 30-32, and column 4: lines 39-57, each of which are recited in section 3 above.

Yamakita teaches an apparatus whereby, for a designated electronic document, for all "proper noun" words in the document, or for words that are not "general ideas" and "appear frequently" in the document, a network search is performed for data related to said words, an address links to said network data are added into the document via a pointers to a link destination table, and the words are highlighted in the document. **Nowhere in Yamakita is reference made to documents rendered on a computer display device, or to methods or means for detecting the desired words in the document on said device.**

Based on these arguments, **neither Lee, Thorner nor Yamakita teach the Applicant's claimed computer-readable medium having computer executable instructions for automatically detecting information in an electronic document rendered on a computer display device.** Additionally, **neither Lee, Thorner nor Yamakita teach the Applicant's claimed computer executable instructions for automatically retrieving data related to each person identified in said document rendered on said computer display device.** Accordingly, no prima facie case of obviousness has been established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that rejected claims 37, 38, 40-45 and 50 are patentable under 35 USC 103(a) over Lee in view of Thorner and further in view of Yamakita. Accordingly, it is respectfully requested that these claims be reconsidered based on the non-obvious claim language as exemplified in claim 37:

"A computer-readable medium having computer executable instructions for dynamically modifying an electronic document rendered on a computer display device, said computer executable instructions comprising:

automatically detecting any information in the electronic document that represents at least one person;

automatically identifying each person based on a comparison of the detected information to data in at least one electronic database;

automatically retrieving data related to each identified person from at least one electronic database;"

11. Rejection of Claim 39 Under 35 USC §103(a)

The aforementioned Office Action of August 9, 2005 rejected dependent claim 39 under 35 USC §103(a) as being obvious over Lee in view of Thorner in view of Yamakita and further in view of Dimitrova. The Applicant respectfully disagrees with this contention of obviousness.

More particularly, based on the arguments presented in section 10 above and the Examiner's statements regarding Dimitrova, **neither Lee, Thorner, Yamakita nor Dimitrova teach the Applicant's claimed computer-readable medium having computer executable instructions for automatically detecting information in an electronic document rendered on a computer display device.** Additionally, **neither Lee, Thorner, Yamakita nor Dimitrova teach the Applicant's claimed computer executable instructions for automatically retrieving data related to each person identified in said document rendered on said computer display device.** Accordingly, no prima facie case of obviousness has been established in accordance with the holding of In Re Fine. This lack of prima facie showing of obviousness means that rejected claim 39 is patentable under 35 USC 103(a) over Lee in view of Thorner in view of Yamakita and further in view of Dimitrova. Accordingly, it is respectfully requested that this claim be reconsidered based on the non-obvious claim language as exemplified in claim 37 and recited in section 10 above.

12. Rejection of Claims 16-19 and 21-23 Under 35 USC §103(a)

The aforementioned Office Action of August 9, 2005 rejected dependent claims 16-19 and 21-23 under 35 USC §103(a) as being obvious over Lee in view of Thorner and further in view of Appelman et al., US Patent No. 6,539,421 (hereinafter Appelman). The Applicant respectfully disagrees with this contention of obviousness.

More particularly, based on the arguments presented in section 3 above and the Examiner's statements regarding Appelman, **neither Lee, Thorner nor Appelman teach the Applicant's claimed system for automatically retrieving, from at least one electronic database, information relating to each identified person resulting from the automatic parsing of an electronic document.** Accordingly, no prima facie case of obviousness has been established in accordance with the holding of In Re Fine. This lack of prima facie showing of obviousness means that rejected claims 16-19 and 21-23 are patentable under 35 USC 103(a) over Lee in view of Thorner and further in view of Appelman. Accordingly, it is respectfully requested that these claims be reconsidered based on the non-obvious claim language as exemplified in claim 1 and recited in section 3 above.

13. Rejection of Claims 31-34 Under 35 USC §103(a)

The aforementioned Office Action of August 9, 2005 rejected dependent claims 31-34 under 35 USC §103(a) as being obvious over Lee in view of Thorner and further in view of Appelman et al., US Patent No. 6,539,421. The Applicant respectfully disagrees with this contention of obviousness.

More particularly, based on the arguments presented in section 4 above and the Examiner's statements regarding Appelman, **neither Lee, Thorner nor Appelman teach the Applicant's claimed computer-implemented process for automatically scanning electronic data being rendered on a computer display device.** Additionally, **neither Lee, Thorner nor Appelman teach the Applicant's claimed computer-implemented process for automatically retrieving information, from at least one electronic database, relating to each identified person resulting from the automatic scanning of said electronic data.** Accordingly, no prima facie case of obviousness has been established in accordance with the holding of In Re Fine. This lack of prima facie showing of obviousness means that rejected claims 31-34 are patentable under 35 USC 103(a) over Lee in view of Thorner and further in view of Appelman. Accordingly, it is respectfully requested that these claims be reconsidered based on the non-obvious claim language as exemplified in claim 24 and recited in section 4 above.

14. Rejection of Claims 46-49 Under 35 USC §103(a)

The aforementioned Office Action of August 9, 2005 rejected dependent claims 46-49 under 35 USC §103(a) as being obvious over Lee in view of Thorner in view of Yamakita and further in view of Appelman. The Applicant respectfully disagrees with this contention of obviousness.


More particularly, based on the arguments presented in section 10 above and the Examiner's statements regarding Appelman, **neither Lee, Thorner, Yamakita nor Appelman teach the Applicant's claimed computer-readable medium having computer executable instructions for automatically detecting information in an electronic document rendered on a computer display device.** Additionally, **neither Lee, Thorner, Yamakita nor Appelman teach the Applicant's claimed computer executable instructions for automatically retrieving data related to each person identified in said document rendered on said computer display device.** Accordingly, no prima facie case of obviousness has been established in accordance with the holding of In Re Fine. This lack of prima facie showing of obviousness means that rejected claims 46-49 are patentable under 35 USC 103(a) over Lee in view of Thorner in view of Yamakita and further in view of Appelman. Accordingly, it is respectfully requested that these claims be reconsidered based on the non-obvious claim language as exemplified in claim 37 and recited in section 10 above.

Application No. 09/681,183
Reply to Office Action of August 9, 2005

Summary

In view of the above, it is respectfully submitted that claims 1, 2 and 4-50 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-2 and 4-50 and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,



Lyon & Harr
300 Esplanade Drive, Suite 800
Oxnard, California 93036
(805) 278-8855

Mark A. Watson
Registration No. 41,370
Attorney for Applicant